IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

		Docket: 186714/US
First Named Inventor:	Daniel L. Dunn	
Application No.:	10/688,858	Confirmation No. 9455
Filing Date:	October 17, 2003	Examiner: Linh Giang Le
Title:	SYSTEM AND METHOD FOR ASSESSING HEALTHCARE RISKS	Group Art Unit: 3626

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANTS' REPLY BRIEF

Dear Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed on October 31, 2007. The following comments are made in response to the arguments raised in the Examiner's Answer. Applicants also maintain the arguments presented in their Appeal Brief submitted on June 26, 2007.

I. The Focus of this Appeal Is the Patentability of the Claimed Invention, Not the Patentability of the Examiner's Generalized Version of the Invention

The claimed invention is a method and system and method for assessing risk of insuring a healthcare patient in which the following functions are performed:

receiving demographic data **on a patient and prescription data for each prescription filled by the patient**;

assigning the **prescription** data **for each prescription** to at least one risk group **based upon at least one medical condition typically treated by the prescription**;

storing risk data for the patient, **wherein the risk data includes the risk groups for all prescription data of the patient**; and

calculating a risk score for the patient based upon the risk data and the demographic data of the patient. (Emphasis added)

The claim language indicated in bold is not included in the Examiner's version of the rejected claims. Examiner's Answer at 3. However, it is the claimed invention, including all of the recited features and function, and not the Examiner's truncated, generalized version of the invention, that is at issue here.

The Examiner's improper generalization of the claimed invention is necessary to support the alleged motivation to combine the references, which is that all forms of risk assessment, regardless of subject matter, are applicable to one another. See, e.g., Examiner's Answer at 8 ("Robertson's teachings of specific risk classification techniques are reasonably pertinent for assessing risk in any field including health care.") However, looking at the actual claim language, there is no evidence to support the premise that the use of personality trait data to assess automobile driver insurance risk taught in Robertson would logically be combined with the use of prescription data collected in Bienvenu to achieve the specific methodology embodied in the claimed invention.

Additionally, it is the Examiner's burden to establish that each of the claimed features is actually known, such that the asserted combination of references would achieve the claimed combination of features if put together. *KSR* presupposes that all of the claimed features are actually known. *See KSR Int'l. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1741 (2007). As stated in *KSR*, the determination is whether "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Id.* *KSR* does not provide license to use §103 to fabricate features not actually taught or suggested in the prior art.

As discussed in the Appellant's Appeal brief, neither Robertson nor Bienvenu teaches several key features of the claimed invention. In particular, neither reference teaches the claimed functions of "assigning the prescription data for each prescription to at least one risk group based upon at least one medical condition typically treated by the prescription" or "calculating a risk score for the patient based upon the risk data and the demographic data of the patient." The

paragraphs in the references that are cited by the Examiner (Robertson ¶54 and Bienvenu ¶43) simply do not teach or suggest these functions.

II. Robertson's "Risk Classification Techniques" Cannot Plausibly Incorporate Prescription Data

The Examiner repeatedly refers to the Robertson "risk classification techniques," asserting that the additional of the prescription data collected by the Bienvenu system would have been obvious for furthering the analysis of the healthcare insurance risk. E.g., Examiner's Answer at 3, 5, 7-11. Evaluation of this assertion necessitates an understanding of the "techniques" actually taught by Robertson.

Specifically, Robertson teaches (1) a method of devising a survey for use in assessing automobile insurance risks (Figs. 1-2, 5) and (2) a method of classifying a prospective insured into a risk group based upon answers to the survey (Fig. 3). To develop the survey, test survey questions are provided (see ¶¶38-48), and the answers to the questions along with conventional variables of age, martial status, years of driving experience, and number of miles driven per year are collected. ¶ 51. "[T]he survey data is analyzed to determine a set of individual items whose answers significantly predict the number of claims made." ¶52. Notably the conventional variables collected in the survey "were subjected to a regression analysis" and "found to be a fairly crude and inefficient predictor of claim reporting." ¶53. Instead, four survey questions were found to be useful in predicting claim reporting. ¶¶ 54-58. Once the survey has been developed, Robertson teaches a method of classifying prospective insureds into "risk group[s] based on the answers to the survey statements." ¶64.

Given the teachings of Robertson, it is difficult to imagine how or why a "person of ordinary skill in the art would be motivated to combine the Robertson risk classification techniques with the Bienvenu prescription history system in order to assess a healthcare patient's risk effectively and accurately" as asserted by the Examiner. Would the prescription data take the place of the personality trait survey data used to develop a questionnaire? Would the prescription data be used to somehow classify potential insureds into risk groups? If so, would it replace the survey data or be used in conjunction with it, and if so, how? The alleged

combination may seem plausible at an abstract level, but it is not when the Robertson technique is examined in detail.

Moreover, Robertson teaches away from such a combination by advocating a simpler, cost-effective solution to auto risk assessment. For example, in addressing the trend of gathering credit information to assess auto insurance risk, Robertson states that the

> use of credit information, however, threatens to create regulatory and legal issues for several reasons, including concerns . . . about increasing intrusions into privacy. Other information may be so costly to collect that it forecloses a proposed classification scheme as unprofitable.

¶ 9. If collection of credit information is seen as unworkable due to cost and legal issues, a risk assessment method requiring collection of prescription data for each potential insured would certainly suffer from similar drawbacks.

Accordingly, it would not have been obvious to one of ordinary skill to combine the asserted references to achieve the present invention as claimed in claims 1-10.

CONCLUSION

For the reasons set forth above as well as those set forth in the Appellant's Appeal Brief, Appellants respectfully request reversal of the Examiner's rejection of claims 1-10 under 35 U.S.C. § 103(a).

Should any additional fees be necessary, the Commissioner is hereby authorized to charge any fee deficiency associated with this paper or request to Deposit Account No. 04-1420.

Respectfully submitted,

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